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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,495	05/04/2001	Denis Khoo	40015980-0010	8842

909 7590 02/26/2003
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EXAMINER

LE, KHANH H

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/849,495

Applicant(s)

KHOO ET AL.

Examiner

Khanh H. Le

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-28 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☒ Claim(s) 7-11, 13-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 4.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Detailed Action

Examiner's Note

1. The Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claims, other passages and figures apply as well. It is requested from the Applicant, in preparing the response, to consider fully the entire references as well as the context of all references passages as potentially teaching all or part of the claimed inventions.

Claim objections.

2. There are no claim 12. Appropriate corrections are required.

Restriction

3. This application contains claims directed to the following patentably distinct species of the claimed invention:

I. Claims 1-6, 14-19 are drawn to methods, system and/or apparatus for classifiable in class/subclass 705/14.

II. Claims 7-11, 13 are related to movies, sports events, drama series, news events, miniseries, classified at least in class/subclass 348/14.01

III. Claims 20-25, 26-28 are related to audio systems, classifiable at least under class/subclass 381/1.

4. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Presently claims 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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7. During a telephone conversation with Mr. James Jakobsen, on January 28, 2003, an election was made without traverse to prosecute the invention of Species I, claims 1-6, 14-19. Affirmation of this election must be made by applicant in replying to this Office Action.

8. Claims 7-11, 13, 20-28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions.

9. The inventions I and II are distinct, each from the other because:

(1) the genus (invention I) as claimed does not require the particulars of the species as claimed for patentability, and (2) that the species (Invention II) has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the inventions of Group I as claimed does not require the particulars of the species II as claimed because drama series, news events, miniseries are the particulars of the species which is not required in the combination invention of Group I for patentability.

Further, the Group II species features, such as cited above, have separate utility by themselves or in other combinations because all these features related to movies, sport events, drama series, news events, miniseries are extra features that are not required in the claims of Group I.

10. The inventions I and III are distinct, each from the other because:

(1) the genus (invention I) as claimed does not require the particulars of the species as claimed for patentability, and (2) that the species (Invention III) has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the inventions of Group I as claimed does not require the particulars of the species III as claimed because "providing content to a listener over a data network" are the particulars of the species which is not required in the invention of Group I for patentability.

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Further, the Group III species features, such as cited above, have separate utility by themselves or in other combinations because all these features related claim 20 (main claim in Species III) are extra features that are not required in the claims of Group I.

11. Because these inventions are distinct for the reasons given above and the search required for Groups II and III is not required for Group I, restriction for examination purposes as indicated is proper.

35 USC 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Examiner has not been able to find support in the specifications for claim 16. In response to this office Action, please point out the specific support for this claim, by page, line numbers.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The meaning of claim 16 is further unclear. It appears from claim 16's language that the user pays ("by making the choice compensation to the content provider") even though ads are being experienced during content presentation. As no support was found for claim 16 and claim 16 seems to be contradicting claim 1, its meaning is unclear.

For prior art application, Claim 16 is interpreted as the user pays ("by making the choice compensation to the content provider") even though ads are being experienced during content presentation. Applicants are required to clarify the scope of Claim 16 and/or make appropriate corrections.

Claim Rejections - 35 U.S.C. § 101

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10. Claims 1 is rejected under 35 U.S.C. 101 because the claimed methods do not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998).

The independently claimed steps of offering options to the user, selecting, communicating, providing content, are abstract and intangible ideas which can be performed mentally between persons without interaction of a physical structure.

Examiner finds no mechanical, electrical, or structural interaction with the claimed method steps ("over a data network" in the preamble is not sufficient as the preamble is often not given patentable weight)

Because the independently claimed invention is directed to abstract and intangible ideas which does not produce a useful, concrete and tangible result, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However in order to consider those claims in light of the prior art, examiner will assume that those claims recited statutorily permitted subject matter.

In order to overcome this rejection, it is suggested that, for example, "over a data network" be included at least in one of the claim 1 steps.

Claim Rejections - 35 U.S.C. § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 1-6, 14-19 are rejected under 35 U.S.C. 103(a) as unpatentable over Dedrick, US 5752238.**

Dedrick discloses:

1. A method for providing a content from a content provider to a viewer over a data network, **the content being associated with an option**, comprising:
offering to the viewer the option, the option being a choice between
a first choice of viewing the content without an advertisement being displayed during the content
by making a choice compensation to the content provider from the viewer (see e.g. C11 l. 15-36)
, and
a second choice of viewing the content with the advertisement being displayed during the content
by not making the choice compensation to the content provider from the viewer (see e.g., C1-C2
l. 10; C3 l. 65-C4 l. 5; C11-C13 l. 17: obviously, in the Derrick's multiple options of subsidized
content consumption is the option of not viewing ads and paying full price) ;
selecting, by the viewer, the first choice or the second choice (C2 l. 1-2; C11-C13 l. 17);

communicating the option selected to the content provider (C11-C13 l. 17); and providing the content, from the content provider to the viewer, based on the option selected (see e.g. C 3 l. 24-53) .

2. The method of claim 1, wherein the step of offering the viewer the option further comprises: offering the viewer the option over a content display device (see e.g. C5 l. 44-60) .
3. The method of claim 2, wherein the step of offering 5 the viewer the option further comprises: offering the viewer the option over an intelligent television (see e.g. C4 l. 62- C5 l. 16)
4. The method of claim 2, wherein the step of offering the viewer the option further comprises: offering the viewer the option over a computer (see e.g. C4 l. 62- C5 l. 16).
5. The method of claim 2, wherein the step of offering the viewer the option further comprises: offering the viewer the option over a personal digital assistant.
6. The method of claim 2, wherein the step of offering the viewer the option further comprises: offering the viewer the option over a cellular telephone.

As to claims 5 and 6, Dedrich, , at C5 l. 1-16 , discloses many user interface with the system to communicate the user selections, including voice input.

It is further well-known at the time of Applicants' invention, to use personal digital assistants, such as Palm Pilot, or cellular phones as communication means , therefore it would have been obvious to one having ordinary skill in the art, at the time of Applicants' invention was made, to add PDA's and cellular phones as another user interface means to extend Dedrick's applications to such other means.

14. The method of claim 1, wherein the step of selecting the first choice or the second choice further comprises:

transmitting, by the viewer, the first choice or the second choice selected by the viewer over the data network to the content provider (see e.g. col 3-5 , GUI methods)

15. The method of claim 1, wherein the step of offering the viewer the option further comprises: making the choice compensation, the choice compensation being a fee paid to the content provider from the viewer (see e.g. C11 l. 15-36; (see e.g., C1-C2 l. 10; C3 l. 65-C4 l. 5; C11-C13 l. 17: implicit in the Dedrick's multiple options of subsidized content consumption is the option of not viewing ads and paying full price)

16. The method of claim 1, further comprising:
offering to the viewer a third choice of viewing the content with an embedded advertisement being displayed during the content by making the choice compensation to the content provider from the viewer, the embedded advertisement being displayed as part of the content.

claim 16's language is interpreted as the user pays (" by making the choice compensation to the content provider" even though ads are being experienced during content presentation.

Dedrich discloses advertisement viewing while some of the cost of the content is still being borne by the user (multiple options, sliding scales, etc... see e.g. some citations above), therefore another option("a third") is provided as claimed. As to an embedded ad, Dedrick does not specifically disclose such but Official Notice is taken that embedded ads are well-known at the time of Applicant's application therefore one skilled in arts would have known to use such embedded ads into content techniques in Dedrick's system to take advantage of a popular ad presentation technique.

Claims 17, 18 and 19 parallel claim 1 in system, computer readable medium and electronic signal/computer instructions formats, respectively, and are rejected on the same basis.

Conclusion

12. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Goldhaber et al, US 5794210, discloses user

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can normally be reached on Tuesday-Thursday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

KHL

Feb 24, 2003

KHL

Stephen Gravini for me

STEPHEN GRAVINI
PRIMARY EXAMINER